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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/517,587

12/09/2004

Tiziano Dall'Occo

FE 6023 (US)

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34872

7590

07/24/2006

BASELL USA INC.  
INTELLECTUAL PROPERTY  
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EXAMINER

KLEMANSKI, HELENE G

ART UNIT

PAPER NUMBER

1755

DATE MAILED: 07/24/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/517,587

**Applicant(s)**

DALL'OCCO ET AL.

**Examiner**

Helene Klemanski

**Art Unit**

1755

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on amendment filed March 20, 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>3/20/06</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Response to Amendment***

1. Claims 1, 2, 4, 5, 8, 10, 11 and 14-16 have been amended, none of the claims have been deleted and no new claims have been added. Hence, claims 1-16 are pending in the application.
2. The objection to claim 14 as set forth in the previous Office Action dated December 16, 2005 has been overcome by applicant's amendment and is now withdrawn.
3. The 112, second paragraph rejections to the claims as set forth in the previous Office Action dated December 16, 2005 have been overcome by applicants amendments and are now withdrawn.
4. The 103(a) rejection over Menconi et al. (WO 00/058368) in view of Zambon et al. (US 6,451,726) as set forth in the previous Office Action dated December 16, 2005 has been overcome by applicant's arguments and is now withdrawn.
5. The 103(a) rejection over Menconi et al. (WO 00/058368) in view of Zambon et al. (US 6,451,726) and further in view of Kao et al. (US 5,200,502) as set forth in the previous Office Action dated December 16, 2005 has been overcome by applicant's arguments and is now withdrawn.
6. The provisional obviousness type double patenting rejection over copending Application 10/468,640 as set forth in the previous Office Action dated December 16, 2005 has been withdrawn since that application is now abandoned.

### ***Double Patenting***

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 1-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over allowed claims 20-38 of copending Application No. 10/506,176. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a process for the co-polymerization of olefins wherein the olefin may be ethylene, propylene or butane which is contacted with a catalyst comprising Mg, Ti, aluminum and diether compound. A prima facie case of obviousness may be made when chemical compounds have very close structural similarities and similar utilities.

"An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skill in the art to make a claimed compound, in the

expectation that compounds similar in structure will have similar properties.” See MPEP §2144 and §2144.08, paragraph II.A.4.(c).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 15 and 16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-9 of copending Application No. 10/503,104. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a process for the polymerization of olefins (ethylene), which is contacted with a catalyst comprising Mg, Ti, aluminum and diether compound. A prima facie case of obviousness may be made when chemical compounds have very close structural similarities and similar utilities.

“An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skill in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties.” See MPEP §2144 and §2144.08, paragraph II.A.4.(c).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

10. Claims 1-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over allowed claims 23-44 of copending Application No. 10/493,636. Although the conflicting claims are not identical, they are not patentably distinct from each other because each of the components claimed in the instant application are claimed by their full formulaic form in the

compending application. The Ti adduct is found in the metallocene of the compending application and the OR, Cl and Mg can be found in the magnesium compound  $MgCl_2m(ROH)$  adduct in the compending application. An ether electron donor is also disclosed as well as an aluminum alkyl compound. A prima facie case of obviousness may be made when chemical compounds have very close structural similarities and similar utilities.

“An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skill in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties.” See MPEP §2144 and §2144.08, paragraph II.A.4.(c).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

11. Claims 1-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over allowed claims 1-15 and 22-25 of compending Application No. 10/362,695. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a catalyst component comprising a magnesium compound, titanium compound, an electron donor comprising ethers and an aluminum alkyl compound and process for the polymerization of olefins. A prima facie case of obviousness may be made when chemical compounds have very close structural similarities and similar utilities.

“An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skill in the art to make a claimed compound, in the

expectation that compounds similar in structure will have similar properties.” See MPEP §2144 and §2144.08, paragraph II.A.4.(c).

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

12. Claims 15 and 16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of U.S. Patent No. 7,019,097. Although the conflicting claims are not identical, they are not patentably distinct from each other because both claim a process for polymerizing ethylene with an olefin having a hydrocarbon radical with 1-12 carbon atoms in the presence of a catalyst system comprising Mg, halogen (includes Cl), ether, Ti and an aluminum compound wherein the oxidation state of Ti is less than 4+ and the weight percentages of each of the components are overlapping with the instant claims. A prima facie case of obviousness may be made when chemical compounds have very close structural similarities and similar utilities.

“An obviousness rejection based on similarity in chemical structure and function entails the motivation of one skill in the art to make a claimed compound, in the expectation that compounds similar in structure will have similar properties.” See MPEP §2144 and §2144.08, paragraph II.A.4.(c).

Applicants should note that the above obviousness type double patenting rejection over US Patent No. 7,019,907 was a provisional obviousness type double patenting rejection over copending Application No. 10/471,497 in the previous Office

Action dated December 16, 2005 but has been changed to an obviousness type double patenting rejection since the above copending application has now become a patent.

### ***Response to Arguments***

Applicants requested that the above obviousness-type double patenting rejections be held in abeyance. Applicants should note that the examiner cannot indicate allowable subject matter since the obviousness-type double patenting rejections remain in the present application. These claims cannot be indicated as allowable until applicants file a terminal disclaimer. The examiner will **only** consider a terminal disclaimer if it is filed in response to **this** Office Action.

### ***Conclusion***

13. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

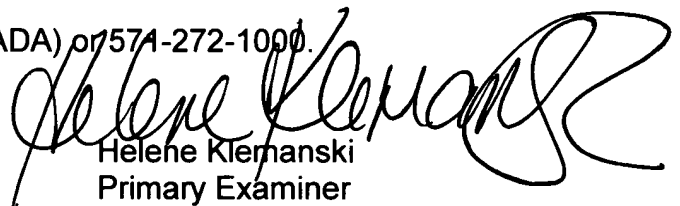


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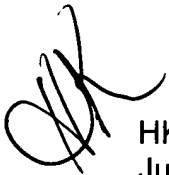
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Helene Klemanski whose telephone number is (571) 272-1370. The examiner can normally be reached on Monday-Friday 5:30-2:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry Lorengo can be reached on (571) 272-1233. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Helene Klemanski  
Primary Examiner  
Art Unit 1755



HK  
July 19, 2006